

REMARKS

Applicants wish to thank the Examiner for the interview of August 12, 2010 with Anthony Tridico. The substance of the interview is explained in the Examiner Interview Materials presented at the August 12, 2010 interview (8 pages) and attached herein.

By this reply, Applicant has amended claims 1, 6-10, 17, 21, 25, 30, 35, and 36 in accordance with the discussion at the interview. Claims 1-12, 14-19, 21-23, 25, 27-30, and 32-36 are pending in this application. Support for these amendments may be found e.g. in FIG. 1 and at page 6, line 28 to page 7 line 5 of the originally filed specification. No new matter has been added by this Reply.

In the Final Office Action, the Examiner rejected claims 1, 6-10, 17, 21, 25, 30, 35, and 36 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 2, 4-8, 10-12, 16, and 36 under 35 U.S.C. § 102(b) as being anticipated by Kalra (U.S. Patent No. 5,948,359); rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Kalra in view of Rhett (U.S. Patent No. 5,839,091); rejected claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Kalra; rejected claims 17-19, 21-23, 25, 27-30, and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Kalra in view of Ganz (WO 02/064812); and rejected claims 9 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Kalra in view of Bernstein (U.S. Patent No. 5,696,887).

Claims 1, 6-10, 17, 21, 25, 30, 35, and 36 stand rejected under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner asserts that "[c]laims 1, 6, 7, 8, 9, 10, 17, 21, 25, 30, 35, and 36 recites the limitation 'the robotic element'. There is insufficient antecedent basis for this limitation in the claim." (Final Office Action, p. 2, para. 4). Applicants submit that the rejection of claims 1, 6-10, 17, 21, 25, 30, 35, and 36 has

been rendered moot by the amendments to claims 1, 6-10, 17, 21, 25, 30, 35, and 36.

Applicants therefore request that the rejection of claims 1, 6-10, 17, 21, 25, 30, 35, and 36 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Applicants respectfully request the withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-2, 4-8, 10-12, 16, and 36 over Kalra (US 5,948,359). The Final Office Action, at page 2, asserts that Kalra discloses each and every feature of rejected independent claim 1, including that "the reagent section is situated to enable the at least one removable reagent container to be added or removed from the apparatus without interrupting the movement of the robotic element during the staining process." Kalra, however, as discussed at the interview, discloses a staining apparatus wherein a reagent vial holder 120 is removable from the top of the apparatus. See Kalra, FIG. 1. In Kalra, removal of a reagent vial holder 120 requires reaching, from above, through the plane on which the movable arm 30 operates.

Specifically, as illustrated in FIG. 1, Kalra discloses an apparatus in which a movable arm 30 is arranged above an array of slide trays 190. The slide trays 190 are disclosed to be removed from above. Due to this arrangement, removal of the slide trays crosses the plane of the moveable arm. Thus, in order to prevent interference between an operator and the movable arm, Kalra discloses at col. 9, line 66 to col. 10, line 3, that "moveable arm 30 is shown in its home position, to which the arm returns when not in use. The home position is desirably selected to minimize interference with other operations, such as the insertion of microscope slides." Additionally, Kalra, at col. 17, lines 19-21 discloses "that the apparatus can process trays of slides in a manner which completes the prescribed processing on a single tray 190, and then signal the

user to remove the tray and replace it with a fresh tray.” Thus, Kalra discloses an apparatus that signals the user to remove a slide tray 190 and positions the moveable arm 30 in a safe “home position,” during this operation.

In contrast, amended independent claim 1 recites “at least one removable reagent container positioned on a reagent rack. . . wherein the reagent rack is removable below the plane of the robotic element. . . wherein the reagent section is situated to enable the at least one removable reagent container to be added to or removed from that apparatus without interrupting the movement of the robotic element during dispensing of at least one reagent during the staining process.” The structural features recited in amended claim 1 permit the removal of a reagent container from below the robotic element during the dispensing of a reagent. Removal from below the robotic element ensures that the robotic element will not be interfered with by an operator. As discussed in the August 12, 2010 interview, Kalra does not disclose, teach, or suggest these features of amended claim 1.

Kalra, therefore, does not disclose each and every element of amended claim 1, and the §102(b) rejection is not supported. Amended independent claims 6-8, 10 and 36 recite similar features and the §102(b) rejection thereof is also not supported. Claims 2, 4, 5, 11, 12, and 16 variously depend from independent claims 1, 6-8 and 10 are therefore also not anticipated by the cited reference.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 14 and 15 over Kalra. The Office Action asserts that it would have been obvious “to use two dimensional high resolution symbology or data matrix codes in the optical identification art . . . as slide identification in place of a barcode.” As discussed above however,

Kalra does not disclose, teach, or suggest all of the elements of claim 10, from which claims 14 and 15 depend. Therefore, no prima facie case of obviousness is supported.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claim 3 over Kalra in view of Rhett (U.S. Patent No. 5,839,091). The Office Action cites Rhett because Rhett allegedly discloses an “optical sensor (CCD camera).” As discussed during the August 12, 2010 interview, however, Rhett does not disclose, teach, or suggest the above-discussed features of amended independent claim 1 missing from Kalra. Therefore, the cited references, taken alone or in combination, do not disclose every element of amended independent claim 1 and no prima facie case of obviousness is established. Claim 3 depends from claim 1 and is therefore also not obvious in view of the cited references for at least the same reasons.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 17-19, 21-23, 25, 27-30, and 32-34 over Kalra in view of Ganz(WO 02/064812). The Office Action cites Ganz because Ganz allegedly discloses “a staining apparatus with a camera with a control computer.” Amended independent claims 17, 21, 25, and 30 recite subject matter, missing from Kalra, similar to amended claim 1. As discussed during the August 12, 2010 interview, Ganz also does not disclose, teach, or suggest the above-discussed features of amended independent claim 1 missing from Kalra. Therefore, the cited references, taken alone or in combination, do not disclose every element of amended independent claims 17, 21, 25, and 30 and no prima facie case of obviousness is established. Claims 18, 19, 22, 23, 27-29, and 32-34 are variously dependent from claims 17, 21, 25, and 30 and are therefore also not obvious in view of the cited references for at least the same reasons.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 9 and 35 over Kalra in view of Bernstein(U.S. Patent No. 5,696,887). The Office Action cites Bernstein because Bernstein allegedly discloses an "an apparatus for automated tissue assay in which samples are located in two sections which are separated by an element." Amended independent claims 9 and 35 recite subject matter, missing from Kalra, similar to amended claim 1. As discussed during the August 12, 2010 interview, Bernstein also does not disclose, teach, or suggest the above-discussed features of amended independent claim 1 missing from Kalra. Therefore, the cited references, taken alone or in combination, do not disclose every element of amended independent claims 9 and 35 and no prima facie case of obviousness is established.

In view of the foregoing remarks, amendments, and the Examiner Interview of August 12, 2010, Applicants submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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